



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/087,262 | 02/28/2002 | Hugh Svendsen | P216/2359P | 4328 |

29141 7590 09/17/2004

SAWYER LAW GROUP LLP
P O BOX 51418
PALO ALTO, CA 94303

| |
|----------|
| EXAMINER |
|----------|

NGUYEN, CINDY

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2171

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------|---|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/087,262 | SVENDSEN ET AL.  |
| | Examiner Cindy Nguyen | Art Unit 2171 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 February 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 10-29 is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 February 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>02/28/02</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

This is in response to application filed on 02/28/02 in which claims 1-29 are presented for examination.

Information Disclosure Statement

The information disclosure statement filed on 02/28/02 is in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Because it has been placed in the application file, and the information referred to therein has been considered as to the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over (McIntyre et al. (U.S. 200301544178) (McIntyre) in view of Skidgel et al. (U.S 20020093678) (Skidgel).

Regarding claim 1, McIntyre discloses: An automated metadata discovery, assignment, and submission system, comprising: a photosharing service coupled to a network (35, fig. 1, McIntyre) through a server (37, fig. 1, McIntyre), the server storing metadata fields¹ (45, fig. 1 and page 3, 0043, McIntyre); and

¹ A photo album page may contain more than one group of images and therefore features such as titles can be applied to individual groups within a page in the server is the metadata

at least one client computer (20, fig. 1, McIntyre) capable of communicating with the server over the network (35, fig. 1, McIntyre), the client computer storing a plurality digital files and an automation application² (16, fig. 1 and page 3, 0042, McIntyre), wherein, when executed the automation application is functional for;

establishing communication with the photosharing service (35, fig. 1, McIntyre), downloading the metadata fields³ (page 4, 0049, McIntyre),

automatically analyzing the content of a first file and assigning one or metadata values to the downloaded metadata fields based on the analysis⁴ (page 4, 0048, McIntyre),

automatically discovering any pre-existing metadata values associated with the file and using the metadata values to populate corresponding downloaded metadata fields⁵ (page 3, 0046, McIntyre),

and uploading the file and the metadata values to the photosharing service for storage (page3, 0043, McIntyre).

However, McIntyre didn't disclose: displaying both the pre-existing and automatically assigned metadata values to the user for viewing and editing, recording the metadata values assigned to the file for use with a next image. On the other hand, Skidgel discloses: displaying both the pre-existing and automatically assigned metadata values to the user for viewing and editing (page 3, 0038, Skidgel) , recording the metadata values assigned to the file for use with a

² the application using for image metadata to automatically arrange images into a photo album according to various predetermined categories and criteria. The digital images stored at the primary storage location 15

³ a user may download the digital images to the computer 20 in which case the appropriate non-image data is transferred at the same time in the designed format and the original images become that images stored at the user's computer 20 or the image storage facility 35.

⁴ Automatically update the appropriate non-image (metadata) data associated with the images stored at the primary storage location

⁵ the user adds information to the image or product, this added information can be a descriptive caption or title which relates to the content of the image, then the user populates the edited image or specified photocollage to a remote fulfillment site, edited image which have the metadata values also populated as upload to the remote fulfillment site.

next image (page 2, 0030, Skidgel). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include displaying both the pre-existing and automatically assigned metadata values to the user for viewing and editing, recording the metadata values assigned to the file for use with a next image in the system of McIntyre as taught by Skidgel. The motivation being to enable the system provide the user interface for displaying each processed image on a display at the user computer and allow the user for the capturing of additional information to be associated with the digital image and recording the history of the image for later the user can use for editing another image.

Regarding claim 2, all the limitations of this claim have been noted in the rejection of claim 1. In addition, McIntyre/Skidgel discloses: wherein the digital file comprises a digital image (page 3, 0043, McIntyre).

Regarding claim 3, all the limitations of this claim have been noted in the rejection of claim 1. In addition, McIntyre/Skidgel discloses: wherein the automation application allows the user to perform edits on the image prior to uploading (page 2, 0042, McIntyre).

Regarding claim 4, all the limitations of this claim have been noted in the rejection of claim 1. In addition, McIntyre/Skidgel discloses: wherein the automation application includes a graphical user interface (GUI) for displaying the metadata values to the user and for displaying forms by which the user may enter and edit metadata values (fig. 4b1, Skidgel).

Regarding claim 5, all the limitations of this claim have been noted in the rejection of claim 4. In addition, McIntyre/Skidgel discloses: wherein the GUI displays the metadata values in a manner that visually distinguishes various categories of metadata for the user (442A-D, fig. 4b1, Skidgel).

Regarding claim 6, all the limitations of this claim have been noted in the rejection of claim 1. In addition, McIntyre/Skidgel discloses: wherein the automation application includes a plug-in interface (page 4, 0048, McIntyre).

Regarding claim 7, all the limitations of this claim have been noted in the rejection of claim 6. In addition, McIntyre/Skidgel discloses: wherein the automation application provides built-in support for a plurality of image file formats, and wherein file type plug-ins may be added for interacting with the automation application through the plug-in interface to enable the automation application to support new file formats.

Regarding claim 8, all the limitations of this claim have been noted in the rejection of claim 7. In addition, McIntyre/Skidgel discloses: wherein the automation application uses image recognition plug-ins to analyze the image (page 4, 0048, McIntyre).

Regarding claim 9, all the limitations of this claim have been noted in the rejection of claim 1. In addition, McIntyre/Skidgel discloses: wherein the automation application further

includes a history repository for recording the metadata values assigned to the image (page 2, 0030, Skidgel).

Allowable Subject Matter

Claims 10-29 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record and that encountered while searching for the claimed invention fails to anticipate and/or suggest: A method and a computer-readable medium containing program instructions for automatically discovering metadata for digital image files and for submitting the metadata and image files to a network-based photosharing service by an application running on a client computer, the method comprising steps of: retrieving a next image file and using the values assigned to the previous image file to populate a portion of the metadata fields for the current image as recited in claims 10 and 20.

Regarding claims 11-19 and 21-29, these claims depend from claims 10 and 20 respectively and are therefore allowable.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 703-305-4698. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CN

Cindy Nguyen

September 16, 2004

SAFET METJAHIC
SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100